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Terho Kaikuranta

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EXAMINER

PIZIALI, JEFFREY J

ART UNIT

PAPER NUMBER

2629

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/714,532	<b>Applicant(s)</b> KAIKURANTA, TERHO	
	<b>Examiner</b> JEFF PIZALI	<b>Art Unit</b> 2629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-8,11-17,22,23,28 and 29 is/are pending in the application.
- 4a) Of the above claim(s) 22 and 23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1,3-8,11-17,28 and 29 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Election/Restrictions*

1. *Applicant's election with traverse of Invention I (claims 1, 3-8, 11-17, 28, and 29)* in the reply filed on *15 June 2009* is acknowledged. The traversal is on the ground(s):

*"Claim 22 of the Group II claims has the same structure as claim 1 of the Group I claims and would not require any extra search burden or consideration on the part of the Examiner. Similarly, claim 23 merely further limits claim 22 such that the program code is downloaded from a server installed the computer or the network device. This likewise would not impose any added burden"* (see page 2 of the *15 June 2009* Election). This is not found persuasive.

This is not found persuasive because:

In establishing serious burden in accordance with MPEP §808.02, the examiner must show either separate classification thereof, a separate status in the art when they are classifiable together, or a different field of search.

The examiner has shown the inventions have separate classification:

Where Invention I is drawn to a method (*claims 1, 3-8, 11-17, and 29*) and a method (*claims 28*), and classified in class 715, subclass 800 (*e.g., methods for resizing via a graphical user interface*), and

Where Invention II is drawn to a computer program product (*claims 22 and 23*), and classified in class 178, subclass 18.03 (*e.g., products digitizing writing coordinates*).

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This clearly shows that each invention has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search.

Moreover, the process for using the product as claimed (*in claims 1, 3-8, 11-17, 28, and 29*) can be practiced with another materially different product (*than that of claims 22 and 23*).

For example, the process as claimed (*in claims 1, 3-8, 11-17, 28, and 29*) can be practiced with another materially different product (*than that of claims 22 and 23*) not including at least:

***"A computer program product comprising a computer readable storage medium storing program code thereon for use by a computer or a network,"*** as claimed in independent claim 22 (*lines 1*); and

***"instructions,"*** as claimed in independent claim 22 (*lines 4-10*).

Additionally, the product as claimed (*in claims 22 and 23*) can be used in a materially different process of using that product (*than that of claim 28*).

For example, the product as claimed (*in claims 22 and 23*) can be used in a materially different process of using that product (*than that of claim 28*) without at least:

***"a graphic user interface,"*** as claimed in independent claim 28 (*line 4*);

***"a zooming mode,"*** as claimed in independent claim 28 (*line 10*);

***"detecting a motion/variation of said second position,"*** as claimed in independent claim 28 (*line 12*);

***"zooming in said graphic user interface,"*** as claimed in independent claim 28 (*line 13*);  
and

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**"zooming out said graphic user interface,"** as claimed in independent claim 28 (*line 15*).

The requirement is still deemed proper and is therefore made FINAL.

2. ***Claims 22 and 23 are withdrawn*** from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on *15 June 2009*.

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:

***I. Claims 1, 3-8, 11-17, and 29***, drawn to a subcombination method, classified in class 715, subclass 858 (*i.e., methods of automatic position adjustment*).

***II. Claim 28***, drawn to a combination method, classified in class 715, subclass 798 (*i.e., methods for combined movement and resizing operations*).

The inventions are distinct, each from the other because of the following reasons:

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4. Inventions **II** and **I** are related respectively as combination and subcombination.

Inventions in this relationship are distinct if it can be shown that:

(1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and

(2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)).

(1) In the instant case, the **Combination** (in claim 28) as claimed does not require the particulars of the **Subcombination** as claimed (in claims 1, 3-8, 11-17, and 29) because:

The **Combination** as claimed (in claim 28) does not require:

"receiving a first position signal," as claimed in independent claim 1 (line 4);

"forming a first position on a touch based user input device in response to the first position signal," as claimed in independent claim 1 (lines 5-6);

"receiving a second position signal," as claimed in independent claim 1 (line 7);

"determining if said second position signal is a part of a simultaneous dual point user input comprising the first position signal and the second position signal," as claimed in independent claim 1 (lines 8-9);

"if the second position signal is a part of the simultaneous dual point user input, and if the input device is configured to automatically form a middle position on the input device based on the first and the second position signals," as claimed in independent claim 1 (lines 10-12);  
and

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*"forming a second position on said input device in a relationship to said first position and said middle position," as claimed in independent claim 1 (lines 13-14) of the **Subcombination**.*

(2) Furthermore, the **Subcombination** has separate utility, such as:

The **Subcombination** as claimed (*in claims 1, 3-8, 11-17, and 29*) can be used without requiring:

*"forming a first position in response to a first user input to a touch based user input device having a graphic user interface," as claimed in independent claim 28 (lines 3-4);*

*"forming a second position in response to a second user input to said input device, wherein said second user input is subsequent to said first user input," as claimed in independent claim 28 (lines 6-7);*

*"determining if said second user input is a part of a simultaneous dual point user input including the first user input and the second user input," as claimed in independent claim 28 (lines 8-9);*

*"switching said graphic user interface into a zooming mode, if said second user input is a part of a simultaneous dual point user input," as claimed in independent claim 28 (lines 10-11);*

*"detecting a motion/variation of said second position," as claimed in independent claim 28 (line 12);*

*"zooming in said graphic user interface, if said second position approaches said first position," as claimed in independent claim 28 (lines 13-14); and*

*"zooming out said graphic user interface, if said second position recedes said position," as claimed in independent claim 28 (lines 15-16) of the **Combination**.*

The examiner has required restriction between combination and subcombination inventions.

Where applicant elects a subcombination, and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a).

Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

5. Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);



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(d) the prior art applicable to one invention would not likely be applicable to another invention;

(e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

**Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.**

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeff Piziali whose telephone number is (571) 272-7678. The examiner can normally be reached on Monday - Friday (6:30AM - 3PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chanh Nguyen can be reached on (571) 272-7772. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeff Piziali/  
Primary Examiner, Art Unit 2629  
20 October 2009